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| 09/770,978 | 01/26/2001 | Dimitri Kanevsky | YOR92000042US1(13772) | 8004 |

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09/08/2003

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EXAMINER

HUYNH, BA

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/770,978.

Applicant(s)

KANEVSKY ET AL.

Examiner

Ba Huynh

Art Unit

2173

-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

BA HUYNH
PRIMARY EXAMINER

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 11-22, drawn to the displaying of icon based on determined content of a text, classified in class 345, subclass 838.
 - II. Claim 10, drawn to the topic classification and segmentation of a file, classified in class 715, subclass 515.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as for dividing a file into parts using segmentation and topic classification. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Mr. John Sysney on 8/27/03 a provisional election was made with traverse to prosecute the invention of group I, claims 1-9, 11-22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 10 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 2173

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between the composite icon and the body of the claim.

6. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 20, line 1, the phrase “which” is not clear as to whether the applicants are referring to the icon or the advertisements.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 5-9, 11, 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by

US Patent Application Publication 2002/0038299 (Zernik et al).

- As for claims 1, 7, 11, 16, 18: Zernik et al teach a computer implemented method and corresponding system, comprising the steps/means for:

extracting the content of a text file by examining words in a file (0019, 0043),

associating the content with an icon 804 (0025),

selecting an icon to represent the text file on the basis of the determined content of the text file, i.e., the interactive image associated with a web page (0020, 0059, figures 8, 9),

displaying the icon.
- As for claim 2: The icon is selected as a closest one from a group of icons to represent the text file (0058).
- As for claim 3: The system includes means for determining several topics and generating several thumbnails for the text file (0042).
- As for claim 5: The icons can be sensed by different senses, e.g., visually inspected or touched by the user (figures 8, 9).
- As for claim 6: The displayed icons facilitate use of a computer by people with vocal and hearing disabilities.

Art Unit: 2173

- As for claim 8: The means for extracting content includes means for associating a text file with a language model, and words, keywords, and key phrases counts (0043, 0044), a topic identifier to identify a topic (0045, 0051, 0061), a module that partitions a text in a file by topic count (0062, 0067).
- As for claim 9: Topics are identified using probabilities of words from language models of text in the file and language models for various topics stored in the database (0043, 0045, 0051).
- As for claims 17, 19: Each icon 804 is associated with words (figure 8). The system includes means for identifying the important and significant of the topics associated with the file based on the extracted content (0058). The topics are compared with words in a database to select one of the icons to represent the file (0053, 0054, 0055).
- As for claim 20: advertisement is inherently included in Zernik's teaching of web pages (0011).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12-13, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0038299 (Zernik et al).

Art Unit: 2173

- As for claims 12, 13: Zernik et al fail to clearly teach the implementation of voice interface for accessing files. However Official notice is taken that implementation of voice interface for accessing computer information is well known in computer art. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the well known implementation of voice interface to Zernik et al. Motivation of the combining is to provide a supplemental interface for those who might need.
- As for claims 21, 22: Zernik et al fail to clearly teach that the user pays less and the advertiser pays manufacturer or seller of the system if advertisements are included. However implementation in which the user pays less and the advertiser pays manufacturer or seller of the system if advertisements are included is well known in electronic advertisement. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the well known implementation that the user pays less and the advertiser pays manufacturer or seller of the system if advertisements are included to Zernik et al. since it readily appears that advertisers are the one who benefit most. Motivation of the combine would have been a fair practice to promote business.

11. Claims 4, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0038299 (Zernik et al), in view of US patent #6,182,090 (Peairs).

- As for claim 4: A file may have more than one icon representing a topic (0059). Zernik et al fail to clearly teach the generating of a composite icon for a file that has

multiple topics. However generating a composite icon for a file is well known as is disclosed by Peairs (figure 2). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Peairs's teaching of generating a composite icon to Zernik's icon representation of a web page. Motivation of the combining is for representing different topics on the page.

- As for claim 15: Zernik et al teach a computer implemented method comprising the steps of:

generating a list of files (0042)

extracting the content of each file (0043),

attaching a topic to each file (0045),

generating icons for the files, i.e., the interactive image associated with a web page (0020, 0059, figures 8, 9),

creating an index of topics (0051),

creating a list of icons to list files (figures 8, 9).

Zernik et al fail to clearly teach the generating of a composite icon for a file that has multiple topics. However generating a composite icon for a file is well known as is disclosed by Peairs (figure 2). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Peairs's teaching of generating a composite icon to Zernik's icon representation of a web page. Motivation of the combining is for representing different topics on the page.

Allowable Subject Matter

Art Unit: 2173

12. Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (703) 305-9794. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

Ba Huynh
Primary Examiner
AU 2173
9/03/03

**BA HUYNH
PRIMARY EXAMINER**

